

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**SERIAL NO:** 75/982917

**APPLICANT:** Alexandria Real Estate Equities, Inc.

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**MARK:** LABSPACE

**CORRESPONDENT'S REFERENCE/DOCKET NO:** N/A

**CORRESPONDENT EMAIL ADDRESS:**

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

**EXAMINING ATTORNEY'S APPEAL BRIEF**

Serial Number 75/982917

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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

|            |                                                                                               |   |                 |
|------------|-----------------------------------------------------------------------------------------------|---|-----------------|
| Applicant: | ALEXANDRIA REAL ESTATE<br>EQUITIES, INC.                                                      | : | BEFORE THE      |
| Trademark: | LABSPACE                                                                                      | : | TRADEMARK TRIAL |
| Serial No: | 75/982917                                                                                     | : | AND             |
| Attorney:  | SUSAN D. BERNEY-KEY                                                                           | : | APPEAL BOARD    |
| Address:   | COOLEY GODWARD LLP<br>FIVE PALO ALTO SQUARE<br>3000 EL CAMINO REAL<br>PALO ALTO CA 94306-2155 | : | ON APPEAL       |

**EXAMINING ATTORNEY'S APPEAL BRIEF**

The applicant has appealed from the final refusal to register the mark LABSPACE under Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1), on the ground that the mark is merely descriptive of the services.

**FACTS**

The applicant filed an application to register the proposed mark LABSPACE on December 29, 2000 for *"operation of businesses for others, namely life science research; business management; business consulting services; business incubator services, namely business management and business development services in the form of start-up support for businesses of others; rental and leasing of office machinery and equipment"; "real estate services, namely, real estate brokerage, leasing and management services; land acquisition, namely real estate brokerage services; rental of real estate, namely rental of commercial, manufacturing, and research and development space, leasing of real property"; "investment brokerage, consultation, and management; financial portfolio management; financial services, namely financial consultation, financial analysis, financial planning, financial management, financial portfolio management, financing services, and providing debt and equity capital; incubator financing services"; "architectural design services; engineering services; real estate development services; building construction and repair services; maintenance and/or repair of*

*buildings, electrical systems, heating and air conditioning systems, and plumbing systems*"; *"rental of warehouse space"*; and *"rental and leasing of computers"*. In the first Office action dated April 18, 2001, the examining attorney refused registration under Section 2(e)(1) on the ground that the proposed mark merely describes the services. The examining attorney enclosed excerpts of articles from the Nexis database showing descriptive use of the wording "lab space" and "laboratory space", as well as an acronym definition of the term "lab".<sup>[1]</sup> Applicant's response of October 22, 2001 set forth arguments in favor of registration. In an Office action dated February 8, 2002, the examining attorney made final the refusal to register under Section 2(e)(1), and submitted additional Nexis evidence showing the terms "lab space" used descriptively in connection with services similar to the applicant. The examining attorney also enclosed Internet evidence showing descriptive use of "lab space".

On August 7, 2002, the applicant filed a request to divide the application. The services highlighted above remained in parent Application Serial No. 76/187873, which was subsequently registered on the Supplemental Register at the applicant's request on August 13, 2003. The applicant continued to argue against the descriptiveness of the remaining services, which were placed in the child Application Serial No. 75/982917, the subject of this appeal. On February 26, 2003, the examining attorney refused the applicant's request for reconsideration. The applicant filed its notice of appeal on December, 2002, and the Office forwarded the file to the examining attorney for her brief on August 16, 2003. (The application was originally sent to the examining attorney on June 30, 2004. However, she did not receive the paperwork, and therefore, the Office re-sent the paperwork on August 16).

## ARGUMENT

THE PROPOSED MARK IS MERELY DESCRIPTIVE BECAUSE IT DESCRIBES A SIGNIFICANT FUNCTION, PURPOSE OR CHARACTERISTIC OF THE APPLICANT'S SERVICES.

A mark is merely descriptive under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1), if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the relevant goods and/or services. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986); *In re MetPath Inc.*, 223 USPQ 88 (TTAB 1984); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979); TMEP §1209.01(b). A mark that

describes an intended user of a product or service is also merely descriptive within the meaning of Section 2(c)(1). *Hunter Publishing Co. v. Caulfield Publishing Ltd.*, 1 USPQ2d 1996 (TTAB 1986); *In re Camel Mfg. Co., Inc.*, 222 USPQ 1031 (TTAB 1984); *In re Gentex Corp.*, 151 USPQ 435 (TTAB 1966).

Applicant's proposed mark is LABSPACE. Evidence included in the April 18, 2001 and February 8, 2002 Office actions from the Nexis database demonstrates that the wording "lab space" is recognized as referring to space in buildings used for laboratory purposes. The evidence of record includes an acronym definition that defines "lab" as a shortened version of "laboratory". In the Office action dated April 18, 2001, the examining attorney included a number of excerpts of articles from the Nexis database as follows:

The Washington Times (April 16, 2001): "...the General Services Administration...sought \$92 million in funding to build the project's second phase, and \$9 million to design the third phase, office and **lab space** for the Center for Devices and Radiological Health";

The Houston Chronicle (April 12, 2001): "CNI has about 10 employees now and has taken office and **lab space** near Interstate 10 and Texas 6";

Pittsburgh Post-Gazette (April 12, 2001): "To expand research, for example, it needs **lab space** that it doesn't have...";

News & Record (April 5, 2001): "The company is eyeing the Piedmont Triad Research Park in downtown Winston-Salem because it offers **incubator lab space** that is not available in Greensboro...";

Crain's New York Business (April 2, 2001): "What we lack is affordable commercial **lab space**, which means that companies out of the **incubator stage** have to look elsewhere for space to expand";

The Houston Chronicle (April 1, 2001): "The two-story building will have offices, **lab space** and training rooms";

The Courier-Journal (March 29, 2001): "The expansion nearly doubles the space in the building, providing seven full-size, state of the art teaching laboratories compared with three before the construction. It also provides additional research **lab space**, including one lab just for students...";

In the Office action dated May 4, 2003, the examining attorney enclosed the following Nexis articles to show that the wording "lab space" is descriptive:

The Times Union (January 31, 2002): "In addition to **lab space**, the Bender Laboratory also would house **incubator space** for drug discovery enterprises...";

The Herald-Sun (January 24, 2002): “*Scientific Properties is actively pursuing other development opportunities, and Rothschild would love to create more **lab space**...*”;

The San Diego Union-Tribune (January 18, 2002): “*...Phase 3 Properties, a firm that specializes in building biotech **lab space**”;*

Crain’s Detroit Business (January 7, 2002): “*The company settled into new **lab space** at the Karmanos Cancer Institute at Wayne State University. ‘We do see (laboratory and **incubator space**) as a n issue that needs to be addressed...’*”;

The Washington Post (December 17, 2001): “*The company moved into its current facility in November 2000 after it outgrew its **lab space** at the Maryland Technology Development Center, a Rockville business **incubator**”.*

These articles demonstrate that the wording “lab space” does not serve a source identifying function, but rather identifies a desired type of location for businesses, which the applicant helps start up companies obtain, and therefore, clearly demonstrates use of the mark as descriptive as applied to the applicant’s services.

The applicant argued that the evidence of record consists of articles that refer to “lab space” and “laboratory space” as physical locations and buildings. (Aug. 7, 2002 response at 8). The applicant also argued that the evidence does not tie the wording “lab space” to offering of “critical” services, and does not show use of the mark to describe the types of services of issue. (Brief at 6) The applicant has argued that a “consumer would have to use.... imagination to make the leap....to ascertain the nature of the services that are actually offered in the present application (Brief at 3). The applicant has also noted that none of the articles cite use of “lab space” as one word, as used by the applicant. (Oct. 18, 2001 at 7), and that no use of the wording “lab space” by competitors has been made of record. (Brief at 9). The applicant has also argued the applicant’s mark does not indicate that the services provided in connection with the mark are financial, incubation and consulting services, and that “the mark does not describe these services with any degree of particularity”. (Aug. 7, 2002 response at 5).

A term need not describe all of the purposes, functions, characteristics or features of the goods and/or services to be merely descriptive. For the purpose of a Section 2(e)(1) analysis, it is sufficient that the term describe only one attribute of the goods and/or services to be found merely descriptive. *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338 (TTAB 1973); TMEP §1209.01(b). It is a well settled legal principle that where a mark may be merely descriptive of

one or more items of goods in an application but may be suggestive or even arbitrary as applied to other items, registration is properly refused if the subject matter for registration is descriptive of any of the goods for which registration is sought. (See *In re Analog Devices, Inc.*, 6 U.S.P.Q.2d 1808, 1810 (T.T.A.B. 1988), *aff'd*, 871 F.2d 1097, 10 U.S.P.Q.2d 1879 (Fed. Cir. 1989) (applying the same principle to generic names). (See McCarthy, Trademarks and Unfair Competition § 11:50; § 11:51) (4<sup>th</sup> Ed., 2003).

The determination of whether a mark is merely descriptive is considered in relation to the identified goods and/or services, not in the abstract. *In re Polo International Inc.*, 51 USPQ2d 1061 (TTAB 1999) (Board found that DOC in DOC-CONTROL would be understood to refer to the “documents” managed by applicant’s software, not “doctor” as shown in dictionary definition); *In re Digital Research Inc.*, 4 USPQ2d 1242 (TTAB 1987) (CONCURRENT PC-DOS found merely descriptive of “computer programs recorded on disk;” it is unnecessary that programs actually run “concurrently,” as long as relevant trade clearly uses the denomination “concurrent” as a descriptor of this particular type of operating system); *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985); *In re American Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985) (“Whether consumers could guess what the product is from consideration of the mark alone is not the test”); TMEP §1209.01(b).

A mark that combines descriptive terms may be registrable if the composite creates a unitary mark with a separate, nondescriptive meaning. However, if each component retains its descriptive significance in relation to the goods or services, the combination results in a composite that is itself descriptive. See *In re Tower Tech, Inc.*, 64 USPQ2d 1314 (TTAB 2002) (SMARTTOWER merely descriptive of “commercial and industrial cooling towers and accessories therefor, sold as a unit”); *In re Sun Microsystems Inc.*, 59 USPQ2d 1084 (TTAB 2001) (AGENTBEANS merely descriptive of computer software for use in development and deployment of application programs on global computer network); *In re Putman Publishing Co.*, 39 USPQ2d 2021 (TTAB 1996) (FOOD & BEVERAGE ONLINE held to be merely descriptive of news and information service for the food processing industry); *In re Copytele Inc.*, 31 USPQ2d 1540 (TTAB 1994) (SCREEN FAX PHONE merely descriptive of “facsimile terminals employing electrophoretic displays”); *In re Entenmann’s Inc.*, 15 USPQ2d 1750 (TTAB 1990), *aff’d per curiam*, 928 F.2d 411 (Fed. Cir. 1991) (OATNUT held to be

merely descriptive of bread containing oats and hazelnuts).

The fact that an applicant may be the first and sole user of a merely descriptive or generic designation does not justify registration where the evidence shows that the term is merely descriptive of the identified goods and/or services. *In re Acuson*, 225 USPQ 790 (TTAB 1985) (COMPUTED SONOGRAPHY descriptive of ultrasonic imaging instruments); *In re National Shooting Sports Foundation, Inc.*, 219 USPQ 1018 (TTAB 1983) (SHOOTING, HUNTING, OUTDOOR TRADE SHOW AND CONFERENCE held apt descriptive name for conducting and arranging trade shows in the hunting, shooting and outdoor sports products field); TMEP §1209.03(c).

According to the Internet article of record dated February 7, 2002 from *The Seattle Daily Journal of Commerce*, entitled "Subleasing helps solve lab space shortage", the applicant is "a real estate investment trust (REIT) specializing in acquiring laboratory facilities for lease". The article notes that the applicant is "currently marketing laboratory space for lease in the near future". The applicant's services include business incubator services, start up support, business financing and leasing of computers. Therefore, it is clear from the evidence of record that the applicant's services specifically relate to providing business, equipment and financing support to businesses seeking to acquire "lab", or "laboratory", space. As noted previously, it is not necessary that the wording "lab space" describe all of the applicant's services. Rather, it is sufficient for a finding of descriptiveness that "lab space" describe a purpose or feature of the applicant's services. The function of the evidence of record is to establish that the wording "lab space" and "laboratory space" are descriptive designations as related to businesses, business incubators and business financing services. The wording "lab space" does indeed describe a physical location, and this is exactly the focus of the applicant's services. The applicant specifically provides business and financial services to enable start-up companies to obtain lab space, and therefore, the wording as used with the applicant's services is clearly descriptive because it describes the purpose of the applicant's services. It is irrelevant that the evidence of record does not use "lab space" as one word because the applicant's proposed mark is simply unitary use of those words.

A mark that combines descriptive terms may be registrable if the composite creates a unitary mark with a separate, nondescriptive meaning. However, if each component retains its descriptive

significance in relation to the goods or services, the combination results in a composite that is itself descriptive. *In re Tower Tech, Inc.*, 64 USPQ2d 1314 (TTAB 2002) (SMARTTOWER merely descriptive of “commercial and industrial cooling towers and accessories therefor, sold as a unit”); *In re Sun Microsystems Inc.*, 59 USPQ2d 1084 (TTAB 2001) (AGENTBEANS merely descriptive of computer software for use in development and deployment of application programs on global computer network); *In re Putman Publishing Co.*, 39 USPQ2d 2021 (TTAB 1996) (FOOD & BEVERAGE ONLINE held to be merely descriptive of news and information service for the food processing industry); *In re Copytele Inc.*, 31 USPQ2d 1540 (TTAB 1994) (SCREEN FAX PHONE merely descriptive of “facsimile terminals employing electrophoretic displays”); *In re Entenmann’s Inc.*, 15 USPQ2d 1750 (TTAB 1990), *aff’d per curiam*, 928 F.2d 411 (Fed. Cir. 1991) (OATNUT held to be merely descriptive of bread containing oats and hazelnuts). In this case, the proposed mark does not create a unique, distinctive and non-descriptive meaning as applied to the applicant’s services. It is the examining attorney’s contention that the all of the wording in the applicant’s proposed mark, when viewed together as a single phrase, describes the applicant’s services. Therefore, the proposed mark in its entirety is descriptive.

THE EXISTENCE OF THIRD PARTY REGISTRATIONS CONTAINING THE TERM “SPACE” IS NOT CONVINCING EVIDENCE THAT THE WORDING “LABSPACE” IS NOT DESCRIPTIVE OF THE APPLICANT’S SERVICES IN THIS CASE

The applicant has argued that the PTO has allowed other “SPACE” marks to become registered on the Principal Register for use in connection with related services. (Brief at 4; Oct. 18, 2001 response at 9; Aug. 7, 2002 response at 10). First, since copies of registrations were not provided, these registrations are not part of the record and have not been considered. *In re Hungry Pelican, Inc.*, 219 USPQ 1202 (TTAB 983); *In re Delbar Products, Inc.*, 217 USPQ 859 (TTAB 1981); *Editorial America, S.A. v. Gruner & Jahr AG & Co.*, 213 USPQ 498 (TTAB 1982); *In re The Library Restaurant*, 194 USPQ 446 (TTAB 1977); *In re Duofold Inc.*, 184 USPQ 638 (TTAB 1974). However, without considering the specific registrations cited by the applicant, the citation of other cases in which similar terms are registered is of little value. Wording that is determined to be merely descriptive is not

registerable simply because other, similar, marks appear on the register. (See McCarthy, Trademarks and Unfair Competition § 11:50; § 11:51) (4<sup>th</sup> Ed., 2003). (In re Quik-Print Copy Shops, Inc., 616 F.2d 523, 205 U.S.P.Q. 505, n.8 (C.C.P.A. 1980); Gold Seal Co. v. Weeks, 129 F. Supp. 928, 105 U.S.P.Q. 407 (D.D.C. 1955), aff'd, 230 F.2d 832, 108 U.S.P.Q. 400 (1956), cert. denied, 352 U.S. 829, 1 L. Ed. 2d 50, 77 S. Ct. 41, 111 U.S.P.Q. 467 (1956)).

It is understood that a mark that is descriptive and has not established secondary meaning should not be registered merely "because other such marks appear on the register." (In re Scholastic Testing Service, Inc., 196 U.S.P.Q. 517 (T.T.A.B. 1977) (to convince PTO that SCHOLASTIC was not descriptive of school testing services, applicant introduced registrations of the term for other goods; argument rejected and term held descriptive); In re Consolidated Foods Corp., 200 U.S.P.Q. 477, 481 (T.T.A.B. 1978) ("Prior decisions are not very helpful in deciding the subjective issue of descriptiveness and the actions of Examiners in registered other marks of other parties for different goods are of little assistance in evaluating the adequacy of evidence of secondary meaning in this case.") See McCarthy, Trademarks and Unfair Competition § 11:50; § 11:51) (4<sup>th</sup> Ed., 2003).

## CONCLUSION

The proposed mark, LABSPACE, merely describes a function, feature and purpose of the applied-for services. As such, the mark merely describes the services. For the foregoing reasons, the refusal to register under Trademark Act Section 2(e)(1), 15 U.S.C. 1052(e)(1), for the reason that the mark merely describes the services, should be affirmed.

Respectfully submitted,

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[1] The examining attorney also required amendments to the recitations of services and classifications, with which the applicant subsequently complied.